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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/881,807	06/18/2001	Jean-Marc Ascione	05725.0636-00	8671

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EXAMINER


ELHILO, EISA B

ART UNIT	PAPER NUMBER
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1751

DATE MAILED: 05/20/2004

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary	Application No. 09/881,807	Applicant(s) ASCIONE ET AL.	
	Examiner Eisa B Elhilo	Art Unit 1751	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
 - If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
 - If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
 - Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).
- Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 23 February 2004.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-168 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 1,2,6-57,61-112 and 116-168 is/are rejected.
- 7) ☒ Claim(s) 3-5,58-60 and 113-115 is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
 Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
 Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. _____.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- | | |
|--|---|
| 1) <input checked="" type="checkbox"/> Notice of References Cited (PTO-892) | 4) <input type="checkbox"/> Interview Summary (PTO-413)
Paper No(s)/Mail Date. _____ |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948) | 5) <input type="checkbox"/> Notice of Informal Patent Application (PTO-152) |
| 3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)
Paper No(s)/Mail Date _____ | 6) <input type="checkbox"/> Other: _____ |

DETAILED ACTION

1 This action is responsive to the appeal brief filed on February 23, 2004.

2 Upon further review and consideration the prosecution is reopened. Ex parte prosecution is resumed.

NEW GROUND OF REJECTION

Claim Rejections - 35 USC § 103

3 The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

4 Claims 1-2, 6-31, 40-48, 52-57, 61-86, 95-103, 107-112, 116-141, 150-158 and 162-168 are rejected under 35 U.S.C. 103(a) as being unpatentable over Narasimhan (US 6,315,989 B1) in view of Cotteret et al. (US 5,735,908).

Narasimhan et al. (US' 989 B1) teaches an aqueous emulsion composition for coloring or bleaching of hair comprising cationic homopolymers or copolymers derived from acrylic methacrylic acid wherein the monomer units are selected from the group consisting of acrylamide, methylacrylamide, diacetone-acrylamide, acrylamide or methacrylamide substituted on the nitrogen by lower alkyl, alkyl ester of acrylic acid and methacrylic acid (see col. 15, lines 13-18), wherein the cationic polymers are presented in the amount of 0.1 to 10% by weight which overlapped with the claimed percentage amounts as claimed in claims 40-42 (see col. 14, lines 35-37), Fatty alcohols of cetearyl alcohol in the percentage amount of 4% which falls within the claimed range as claimed in claims 17-21 and 43-45 (see col. 5, lines 1-6 and col. 17,

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Example 3), alkoxylated fatty alcohols that comprises aliphatic alcohols and ethylene oxides such as steareth, ceteth, glyceryl ethers and glyceryl esters which are similar to alkoxylated fatty alcohols as claimed in claims 22-31(see col. 5, lines 56-67 and col. 6, lines 24-57), wherein the alkoxylated fatty alcohols such as steareth-21, presented in the percentage amount of 1.0 % which falls within the claimed percentage ranges as claimed in claims 46-48 (see col. 17, Example 3), fatty acid amides (see col. 7, lines 30-34) and hydrogen peroxide as an oxidizing agent in the percentage amount of 1 to 35% which is overlapped with the claimed ranges as claimed in claims 1 and 52-54 (see col. 3, lines 25-29), other adjuvant such as chelating agents as claimed in claim 55 (see col. 13, line 58). Narasimhan et al. (US' 989 B1) also teaches methods for treating hair similar to those claimed in claims 57, 72-86, 95-103, 107-112, 127-141, 150-158 and 162-165 when the reference's methods comprise applying to the hair the aqueous emulsion composition as described above (see col. 15, line 40-67 and col. 16, lines 1-3).

Although Narasimhan et al. (US' 989 B1) generally teaches the cationic homopolymers or copolymers derived from acrylic methacrylic acid wherein the monomer units are selected from the group consisting of acrylamide, methylacrylamide, diacetone-acrylamide, acrylamide or methacrylamide substituted on the nitrogen by lower alkyl, alky ester of acrylic acid and methacrylic acid, the reference does not teach or disclose at least one cationic homopolymer comprising the repeating units of the claimed formula (I).

Cotteret et al. (US' 908) teaches in analogous art of hair dyeing compositions, a composition comprising a cationic polymer of polyquaternium 37 (see col. 3, lines 50-51), which is further described in the literature, in particular in US. Patent No. 5,958,397 at col. 11, the disclosure of which is incorporated herein by reference, wherein the cationic homopolymer of

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quaternium 37 having a formula similar to the claimed formula (I), when in the claimed formula (1), R1 and R2 are hydrogen atoms, R3 is a methyl radical and R4 is a quaternary amino group having $(\text{CH}_3)_3\text{N}^+-\text{CH}_2-$ as claimed in claims 1-2, 6-16, 57, 61-71, 110 and 116-126. Cotteret et al. (US' 908) also teaches a kit for dyeing hair, which is similar to the kit as claimed in claims 166-168 (see col. 11, claim 23, and col. 12, claim 24-25).

Therefore, in view of the teaching of the secondary reference, one having ordinary skill in the art at the time the invention was made would be motivated to modify the composition of the primary reference of Narasimhan (US 6,315,989 B1) by incorporating the cationic polymer of polyquaternium 37 as taught by Cotteret et al. (US' 908) with a reasonable expectation of success. Such modification would be obvious because the primary reference of Narasimhan et al, suggests the use of cationic polymers in the dyeing composition as conditioning agents (see col. 14, line 34) and the secondary reference of Cotteret et al. (US' 908), clearly teaches the polymer of polyquaternium 37 which is structurally similar to those claimed, and, thus, a person of an ordinary skill in the art would be motivated to use the polymer of polyquaternium 37 in the composition of Narasimhan (US' 989 B1) with a reasonable expectation of achieving successful composition for dyeing hair, and would expect such a composition to have similar properties to those claimed, absent unexpected results. Further, the similarities in chemical structure between the prior art and the claimed compounds and which have similar utilities establishes a prima facie case of obviousness. (In re Payne, 203VSPQ 245).

5 Claims 32-39, 49-51, 87-94, 104-106, 142-149 and 159-161 are rejected under 35 U.S.C. 103(a) as being unpatentable over Narasimhan (US 6,315,989 B1) in view of Cotteret et al. (US 5,735,908) and further in view of Casperson et al. (US 6,156,076).

Although the disclosures of Narasimhan (US' 989 B1) and Cotteret et al. (US' 908), as described above, teach and suggest the use of alkoxylated fatty alcohols such as steareth, ceteth and steraeth and fatty amides such as alkyl methylglucamides in the dyeing compositions (see col. 5, lines 56-64 and col. 7, lines 30-33 of US 6,315,989 B1) and alkoxylated fatty alcohols such as cetystearyl alcohol and fatty amide of linoleic acid (see col. 9, Example 3, of US 5,735,908), the references do not teach or disclose the claimed species of alkoxylated fatty alcohols and the fatty amide species in the claimed amounts.

Casperson et al. (US' 076) in other analogous art of hair dyeing formulations, teaches a composition comprising alkoxylated fatty alcohol of laureth-23 as claimed in claims 32, 87 and 142 (see col. 10, Example 10 and col. 13, claim 7) and fatty amides of lauramide and cocamide that meet the limitations of claims 33-39, 88-94 and 143-149 (see col. 7, lines 31-37), wherein the amides presented in the amounts of 0.15% to 10% and 1.5% to 5% which fall within or overlapped with the claimed percentage amounts as claimed in claims 49-51, 104-106 and 159-161 (see col. 7, lines 38-41 and col. 10, Example 10).

Therefore, in view of the teaching of the secondary reference of Casperson et al. (US' 076), one having ordinary skill in the art at the time the invention was made would be motivated to modify the composition of the primary reference of Narasimhan (US' 989 B1) by incorporating the species of the alkoxylated fatty alcohol of laureth-23 and fatty amides of lauramide and cocamide in the amounts as taught by Casperson et al. (US' 076) to make such a composition with a reasonable expectation of success. Such modification would be obvious because the primary reference of Narasimhan (US' 989 B1), suggests the use of the genus of alkoxylated fatty alcohols and fatty amides in the dyeing composition and Casperson et al. (US'

076) as a secondary reference clearly teaches the species of laureth-23 (alkoxylated fatty alcohol) and lauramide and cocamide (fatty amides) in the hair dyeing composition, and, thus, a person of an ordinary skill in the art would be motivated to select any of the species of the genus taught by the reference, including those of the claims because an ordinary artisan would have the reasonable expectation that any of the species of the genus would have similar properties and thus, the same use as the genus as a whole and also would optimized the amounts of these species in the composition in order to get the maximum effective amounts, and, thus, would expect such a composition to have similar properties to those claimed, absent unexpected results.

Allowable Subject Matter

6 Claims 3-5, 58-60 and 113-115 are objected to as being dependent upon a rejected base claim, but would be allowable if rewritten in independent form including all of the limitations of the base claim and any intervening claims, because the prior art of record do not teach or disclose a composition comprising cationic homopolymer with a repeating units of the claimed formula (1), in which all R1, R2 and R3 are chosen from alkyl, alkenyl groups or all R1, R2 and R3 are chosen from hydrogen atoms as claimed.

Conclusion

7 Applicant's arguments with respect to claims 1-168 have been considered but are moot in view of the new ground(s) of rejection.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Eisa B Elhilo whose telephone number is (571) 272-1315. The examiner can normally be reached on M - F (8:00 -5:30) with alternate Friday off.

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If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Yogendra Gupta can be reached on (571) 272-1316. The fax phone number for the organization where this application or proceeding is assigned is 703-872-9306.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).



Eisa Elhilo
May 15, 2004



Mark Kopec
Primary Examiner